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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,773	08/06/2003	Sidney L. Bursten	2839-002	1703
22208 7590 01/24/2007 ROBERTS, MARDULA & WERTHEIM, LLC 11800 SUNRISE VALLEY DRIVE SUITE 1000 RESTON, VA 20191			EXAMINER ROHWER, JACOB P	
			ART UNIT 2625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			01/24/2007	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/635,773

Applicant(s)

BURSTEN, SIDNEY L.

Examiner

Jacob P. Rohwer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1 Nov 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

*1/12/07*  
**Claims 9 and 16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim ~~12~~<sup>9</sup> specifies in Line 13 "the pre-printed generic custom booklet signature" for which there is no antecedent basis. However, the claim does specify in Line 4 a "pre-printed generic booklet signature", for the basis of the rejection set forth below, examiner will assume Line 13 was meant to specify the generic booklet signature introduced in Line 4. The same indefinite language is specified in claim 16 Lines 4 and 20. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 8-11, 13-18, 20-30, 32-40, 43-53 and 55-57** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 5,114,128 to Harris, Jr et al, in view of US Patent No 6,402,132 to Michaelis et al.

Regarding claim 1, Harris, Jr discloses a booklet system (**Fig 1**) comprising:

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a pre-printed custom booklet signature selected for a targeted recipient and having a content control identifier; **(Col 6 Lin 51-52)**

a content controller, **(Fog 1 #18)** wherein the content controller is adapted to:

use the content control identifier received from the pre-printed custom booklet signature to obtain instructions associated with the targeted recipient; **(Col 6 Lin 58-61, address information for the target recipient is associated with the content control identifier.)** and

use the instructions to create a just-printed custom booklet for the targeted recipient; **(Col 6 Line 62-63, the just printed signature is the cover with the address information printed.)**

Although Harris, Jr discloses assembly of signatures (including covers) to create a personalized magazine using a bindery line, **(Col 6 Lin 46-49)** Harris, Jr does not expressly disclose using the instructions to marry the pre-printed custom booklet signature and the just-printed custom booklet signature to produce a customized booklet for the target recipient.

However, Michaelis discloses using a content control identifier (similar to that of Harris, Jr) to synchronize the matching of signatures intended for the same target recipient. **(Col 3 Lin 28-38)** As a result these "marks" provide instructions for marrying signatures **(including covers, Michaelis Col 3 Lin 33-34)** as disclosed in Harris, Jr. The Walker and the Harris, Jr Patents are combinable because they both come from the same field of endeavor relating to printing customized information on a magazine.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to marry certain signatures based on matching indicia or marks as specified in Michaelis, in order to output the correct personalized cover signature with the correct personalized signatures located within the booklet as specified in Harris, Jr.

The suggestion motivation for doing so would have been to simply provide a synchronization mechanism for outputting the correct booklet (with the correct personalized signature) for the target recipient. **(Michaelis, Col 3 Lin 34-39)**

Therefore it would have been obvious to combine the Harris, Jr and Michaelis Patents in order to obtain the invention of claim 1.

Regarding claim 2, the combination further discloses in Harris, Jr the booklet system of claim 1, wherein the content control identifier is a machine-readable code. **(Fig 2 #56, Col 6 Lin 51-61)**

Regarding claim 3, the combination further discloses in Harris, Jr the booklet system of claim 1, wherein the system further comprises a feeder/scanner adapted to receive the pre-printed custom booklet signature, to read the content control identifier, and to send the content control identifier to the content controller. **(Col 4 Lin 24-43)**

Regarding claim 8, the combination further discloses in Harris, Jr, the booklet system of claim 1, wherein the booklet system is a book or catalog. **(Abstract)**

Regarding claim 9, please see rejection of claim 1 above. Additionally, the combination of Harris, Jr and Michaelis specifies the booklet system as disclosed in claim 1 including marrying a pre-printed custom booklet signature selected for a target recipient **(Harris, Jr Col 6 Lin 51-52)**, a pre-printed generic booklet signature

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**(Michaelis, Col 3 Lin 34-35 discloses combining customized signatures with generic signatures in order to create the booklet), and the just-printed custom booklet signature (Harris, Jr Col 6 Lin 62-63, the cover), to produce a customized booklet for the targeted recipient.**

Regarding claims 10-11, please see rejections of claims 9 and 2-3 above.

Regarding claim 13-14, the combination further discloses the booklet system of claim 9 wherein the content control identifier is associated with profile data (claim 13), and the profile data is an address (claim 14) of the targeted recipient **(Harris, Jr Col 9 Lin 15-22)** and wherein the pre-printed generic booklet signature is selected from a set of pre-printed generic booklet signatures for inclusion in the customized booklet using the profile data. **(Harris, Jr Col 7 Lin 56-66 discloses a selective bindery line with pre-printed signatures, controlled by a data processor.)**

Regarding claim 15, please see rejections of claims 9 and 8 above.

Regarding claim 16, please see rejections of claims 1 and 9 above.

Furthermore, the combination discloses in Harris, Jr one or more pre-printed targeted generic booklet signatures **(Col 1-2 Lin 67-68 and 1-20, Advertisements)** that can be associated and inserted according to the targeted recipient of the customized magazine printed. **(Col 6-7 Lin 64-69 and 1-12)** Furthermore, Michaelis discloses using a content control identifier to instruct and synchronize and match the output of personalized signatures with generic and specialized content as specified in the rejection of claim 1 above. **(Michaelis, Col 3 Lin 33-38)**

Regarding claims 17-18, please see rejections of claims 16 and 2-3 above.

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Regarding claims 20-21, please see rejections of claims 16 and 13-14 above.

Regarding claim 22, please see rejections of claims 21 and 8 above.

Regarding claim 23, please see rejection of claim 1 above. Furthermore the combination discloses in Michaelis, that the printer is a web-fed printer capable of printing customized information, such as the "just-printed" cover as specified in the rejection of claim 1. **(Fig 1 #30, Col 3 Lin 13-34)**

Regarding claims 24-25, please see rejections of claims 23 and 2-3 above.

Regarding claims 26, the combination further discloses in Harris, Jr that the personalized content is an address. **(Col 6 Lin 62-63)**

Regarding claim 27, the combination further discloses in Michaelis that the personalized content is a message. **(Col 3 Lin 31-33, the personalized signature could use content such as likes, dislikes, buying trends, in addition to the address printed on the cover.)**

Regarding claims 28 and 29, the combination further discloses in Harris, Jr, the booklet system of claim 23, wherein the content control identifier is associated with profile data of the targeted recipient and the personalized content is using the profile data (claim 28), and furthermore that the profile data consists of an address (claim 29). **(Col 9 Lin 15-20)**

Regarding claim 30, please see the rejection of claim 1 above, note the personalized just-printed signature and the just-printed custom booklet signature can be the same signature.

Regarding claim 32, please see rejection of claims 23 and 9 above.

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Regarding claim 33, please see rejection of claims 32 and 13 above.

Regarding claim 34, please see rejection of claims 23 and 8 above.

Regarding claim 35, please see rejections of claims 1-3 above. All the limitations specified in claim 35 are included in the rejection of claims 1-3.

Regarding claim 36, please see the rejection of claims 35 and 9 above.

Regarding claim 37, please see rejection of claims 23 and 1-3 above.

Regarding claim 38, please see rejection of claims 37 and 9 above.

Regarding claims 39-40, please see rejections of claims 1 and 2 above.

Additionally the system of claims 1 and 2 performs the methods of claims 39 and 40.

Regarding claim 43, please see rejection of claims 39, 28 and 16 above.

Regarding claim 44, please see rejections of claims 39 and 28-29 above.

Regarding claim 45, please see rejections of claims 43 and 8 above.

Regarding claim 46, please see rejection of claim 23 above. Additionally the system of claim 23 performs the method of claim 46.

Regarding claims 47-53 and 55-57, please see rejections of claims 24-30 and 32-34 above respectively. Additionally the system of claims 24-30 and 32-34 perform the methods of claims 47-53 and 55-57.

**Claims 4-7, 12, 19, 31, 41-42 and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Harris, Jr and Michaelis as specified in claims 1, 9, 16, 30 and 39 above, and further in view of US Patent No 6,240,334 to Duke et al (which incorporates the Harris, Jr Patent, Col 1 Lin 15-20).



Regarding claim 4, the combination of Harris, Jr and Michaelis discloses the booklet system of claim 1 using a web fed printer to print customizable signatures, including covers. **(Michaelis, Col 3 Lin 13-39, Fig 1 #30)**

The combination does not expressly disclose that the just-printed custom booklet signature **(the cover as specified in the rejection of claim 1 above)** is printed on a *sheet-fed printer*.

However, Duke discloses a printing system in which covers are printed off-line using a sheet-fed printer. **(Col 4 Lin 33-38)**

The combination of Harris, Jr and Michaelis and the Duke Patent are combinable because they both come from the same field of endeavor relating to customized printing.

At the time of the invention it would have been obvious to one of ordinary skill in the art, to produce the cover as specified in the combination of Harris, Jr and Michaelis, using the sheet fed mode as specified in Duke.

The suggestion/motivation for doing so would have been to expand the flexibility and extent to which a cover can include personalization, an improvement on the Harris, Jr Patent. **(Duke Col 3 Lin 43-47)** This in combination with the idea that using the web-fed printer in Michaelis that is capable of quicker, mass output of certain customized signatures reads on the claim as submitted.

Therefore, it would have been obvious to combine the Duke Patent with the combination of Harris, Jr and Michaelis in order to obtain the invention as specified in claim 4.

Regarding claim 5, please see rejection of claims 1, 4 and 9 above.

Regarding claims 6-7, please see rejections of claims 5, 13 and 14 above.

Regarding claim 12, please see rejection of claims 9 and 4 above.

Regarding claim 19, please see rejection of claims 16 and 4 above.

Regarding claim 31, please see rejection of claims 30 and 4 above.

Regarding claim 41, please see rejection of claims 39 and 4 above.

Regarding claim 42, please see rejection of claims 41 and 9 above.

Regarding claim 54, please see rejection of claims 53 and 4 above.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection. More specifically, in light of the interview conducted on the 24 of October 2006, and upon further consideration of the Harris, Jr Reference, a new rejection has been formed as specified above. Examiner wants to note, that upon further consideration with regard to Harris, Jr and the current specification, the Harris, Jr Reference has been maintained in the rejection above due to its similarity to the current invention. More specifically, Harris, Jr discloses a system and method to match address information on a cover to address information on customized signatures located within the magazine based on a machine-readable code. Customized as limited by the current specification, is intended only for a specific target recipient as specified in on page 9 of the specification. Based on this limitation, the Harris, Jr has been found to determine address information for a cover based on "customized" information read from pre-printed signatures. Furthermore, the Michaelis

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and Duke Patents have been found to provide matching of personalized information in order to output a booklet using the web-fed and sheet-fed printers as specified in the rejection above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on 571-272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JR

  
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